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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,493

09/26/2005

Michael Bauer

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EXAMINER

ANDLER, MICHAEL S

ART UNIT

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4174

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,493	<b>Applicant(s)</b> BAUER ET AL.	
	<b>Examiner</b> Michael Andler	<b>Art Unit</b> 4174	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>26 September 2005</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

This action is in response to Application Number 10/550493 filed on 26 September 2005, which is a national stage entry of PCT/EP04/03674 and claims the benefit from German Application Number 103 16 771.4, dated 10 April 2003.

### ***Information Disclosure Statement***

The Information Disclosure Statement submitted on 26 September 2005 was considered by examiner.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims **1-4, and 6** are rejected under 35 U.S.C. 102(e) as being anticipated by Royer. (US 7,168,623).

Regarding claim **1**, Royer discloses a self-adhesive security label for a data carrier (Fig 6, item 10: *label*), exemplified by a security document or a document of value, comprising a substrate (Fig 6, item 14: *base*) on the front side of which are applied security features (claim 19: "...*surface of the base which does not receive the double faced adhesive is provided to receive printing of a pattern, text or code.*") and on the back side of which is provided a cold adhesive foil (Fig 6, item 20: *double faced adhesive*), wherein the security label includes an integrated circuit (Fig 6, item 12: *chip*) disposed in a recess (Fig 6, item 21: *slot*) of the adhesive foil adapted to store security data (Col. 1, lines 22-25: "...*large amount of immediately rewritable information can be stored therein...*") and an antenna (Fig 6, item 16: *antenna*) disposed between the substrate and the adhesive foil said antenna connected with the integrated circuit (Fig 6, item 26: *welding bead*) so as to provide a contactless communication with the integrated

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circuit (Col 1, lines 23-25: “...*a large amount of immediately rewritable information can be stored therein, without having to handle the object...*”).

Regarding claim **2**, Royer discloses wherein the recess with the integrated circuit is closed by a covering element (Fig 8, item 22: *resin drop*).

Regarding claim **3**, Royer discloses wherein the antenna is printed on, bonded to or embossed into the substrate (Col. 2, lines 56-58: “*Antenna 16 may be formed on the base in a known manner by metal deposition followed by an etching.*”).

Regarding claim **4**, Royer discloses wherein the front-side security features are selected from the group consisting of a passport photograph, a finely structured pattern (claim 19: “...*surface of the base which does not receive the double faced adhesive is provided to receive printing of a pattern, text or code*) (Ref B), machine readable features (claim 19: “...*surface of the base which does not receive the double faced adhesive is provided to receive printing of a pattern, text or code*), fluorescent substances, magnetic or electrically conductive substances, and a polydimensional bar code (claim 19: “...*surface of the base which does not receive the double faced adhesive is provided to receive printing of a pattern, text or code*).

Regarding claim **6**, Royer discloses wherein the front-side security features at least partially are covered with a foil (Fig 6, item 24: *protective film*) wherein the foil has a thickness of less than 20 micron.

Claims **1, 4-7, 9-14, and 17-18** are rejected under 35 U.S.C. 102(a) as being anticipated by Schneider et al. (CA 2414746).

Regarding claim **1**, Schneider et al. discloses a self-adhesive security label for a data carrier (Fig 1, item 2: *security element*), exemplified by a security document or a document of value (Fig 1, item 1: *bank note*), comprising a substrate (Fig 4, item 5: *carrier layer*) on the front side of which are applied security features (Fig 4, items 14 and 15: *embossed layer and metal layer*) and on the back side of which is provided a cold adhesive foil (Fig 4, item 9: *adhesive layer*), wherein the security label includes an integrated circuit (Fig 6, item 8: *integrated circuit*) disposed in a recess of the adhesive foil (Fig 4) adapted to store security data and an antenna (Fig 4, item 11: *folded dipole*) disposed between the substrate and the adhesive foil said antenna connected (Fig 4, item 12: *conductive adhesive layer*) with the integrated circuit so as to provide a contactless communication with the integrated circuit (Page 4, lines 13-15: "*It is advantageous to use integrated circuits with which communication is effected contactlessly via a coupling element*").

Regarding claim **4**, Schneider et al. discloses wherein the front-side security features are selected from the group consisting of a passport photograph (page 4, lines

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1-2: "...the optical effect can also be produced by any printed image or a metallic layer with gaps in the form of patterns, characters, or the like.") (Ref D), a finely structured pattern (page 12, lines 17-19: "Any other contour forms are of course also possible, including filigree structures such as guilloches, etc."), machine readable features (page 4, lines 2-3: "The metal layer itself can likewise be present in the form of characters or pattern"), fluorescent substances (page 4, lines 3-4: "The use of special printing inks, such as luminescent inks, is also possible"), magnetic or electrically conductive substances (page 4, lines 1-2: "...the optical effect can also be produced by any printed image or a metallic layer with gaps in the form of patterns, characters, or the like."), and a polydimensional bar code. (Page 4, lines 1-3: "...the optical effect can also be produced by any printed image or a metallic layer with gaps in the form of patterns, characters, or the like. The metal layer itself can likewise be present in the form of characters or patterns. The use of special printing inks, such as luminescent inks, is also possible.").

Regarding claim **5**, Schneider et al. discloses wherein the front-side security features contain a printed area produced by an intaglio printing method. (Claim 26: "...that the document of value has a print, in particular, an intaglio print, at least overlapping with the security element.").

Regarding claim **6**, Schneider et al. discloses wherein the front-side security features at least partially are covered with a foil (Fig 4, item 5: *carrier layer* and Page 5,

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lines 28-30, "*The carrier layer can be removed from the layer structure of the security element after transfer, or remain a firm part of the security element on the layer structure as a protective layer.*" ), wherein the foil has a thickness of less than 20 micron.

Regarding claim **7**, Schneider et al. discloses wherein the foil contains holographic diffraction structures (Page 3, lines 20-21, "...*the security element can also have a hologram, kinegram, or other diffraction structure*").).

Regarding claim **9**, Schneider et al. discloses a data carrier carrying a security label according to claim 1 (Fig 1, items 1 and 2: *bank note and security element*).

Regarding claim **10**, Schneider et al. discloses a data carrier according to claim 9, wherein the adhesive strengths of the cold adhesive foil and of the bond between the integrated circuit and the antenna are adjusted relative to each other such that a removal of the security label from the data carrier results in damaging the antenna or separating the antenna from the integrated circuit (Page 4, lines 29-31: "*The inventive security element is preferably applied to the security paper after papermaking and is so connected with the security paper that it cannot be removed without destroying the security paper or the security element.*").).

Regarding claim **11**, Schneider et al. discloses a method for producing a self-adhesive security label for a data carrier including the steps: a) providing a substrate (claim 39: "*a) providing a carrier layer*"); b) applying security features to a front of the substrate (claim 39: "*b) applying at least one layer producing an optical effect*"); c) applying an antenna arrangement to a back of the substrate (claim 39: "*c) vapor-depositing a metallic layer, a coupling element being formed in the metallic layer*"); d) applying a cold adhesive foil with a recess in the area of the antenna arrangement to the back of the substrate which is provided with the antenna arrangement (claim 47: "*e) an adhesive layer, preferably a hot-melt adhesive layer, is applied*"), and e) incorporating an integrated circuit into the recess and connecting the integrated circuit with the antenna arrangement. (claim 39: "*d) applying an integrated circuit*").

Regarding claim **12**, Schneider et al. discloses a method according to claim 11, including applying the antenna arrangement by screen printing conductive inks. (claim 40: "*...a soluble ink is printed on in the form of the coupling element and any further patterns or characters, and that after step c) said ink is removed together with the metallic layer*").

Regarding claim **13**, Schneider et al. discloses a method according to claim 11 wherein the applying step comprises hot stamping or bonding a conductive foil to the back of the substrate. (Page 14, lines 22-24: "*...the metal layers can also be produced*").

*in a first step as all-over metal layers, which are then covered with a protective layer in the desired areas.”).*

Regarding claim **14**, Schneider et al. discloses a method according to claim 11 wherein the recess of the adhesive foil after step e) is closed with a self-adhesive covering element. (claim 47: “e) *an adhesive layer, preferably a hot-melt adhesive layer is applied*”).

Regarding claim **17**, Schneider et al. discloses a method according to claim 11, including carrying out in step b), by providing a printed area on the substrate by an intaglio printing method. (Page 9, lines 15-17: “*During printing, the area of the security element can also be overprinted at least partially, thereby further increasing the forgery-proofness of the document of value, in particular if a tactile steel intaglio print is used for overprinting.*”).

Regarding claim **18**, Schneider et al. discloses a method according to claim 17, wherein the intaglio printing is carried out in sheet format after the steps c) and d) and before step e). (Page 9, lines 7-11: “*The security paper provided with the inventive security elements can then be processed into any documents of value. If bank notes are produced from the security paper for example, the security paper is usually cut into sheets with a plurality of copies that can then be processed in suitable printing machines.*”).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **15 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (CA 2414746) in view of Royer (US 7,168,623).

Regarding claims **15 and 16**, Schneider et al. suggests that *"the individual transfer elements can be prepared on the carrier layer as separate individual elements in the contour forms to be transferred. Alternatively, the layer sequence of the transfer elements is provided on the carrier layer in continuous form. Such carrier layers with spaced-apart individual transfer elements or a continuously extending layer structure will hereinafter be referred to as "transfer material," and the layer sequence of the security element disposed on the carrier layer as the "transfer layer."* (Page 6, lines 1-7) Schneider et al. also suggests that, *"In the case of the continuous transfer layer, the transfer material is then connected with the security paper via an adhesive layer, and the adhesive layer activated via suitable embossing tools so that the transfer layer adheres to the security paper only in the activated areas."* (Page 6, lines 9-12), however, Schneider et al fails to teach wherein step b) is carried out by providing a reel-fed substrate with a background print by offset printing method and wherein the steps c) and d) are effected in a reel-fed manner.

Royer discloses in Figure 10, "*...a method of manufacturing self-adhesive labels according to the embodiment described in relation with FIGS. 3 and 4, which is clearly a reel-fed manner.*"

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize well known methods of manufacturing a continuous form of self-adhesive labels. This method is desirable as suggested by both prior art references.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (CA 2414746) in view of Krut et al. (US 6,830,192).

Regarding claim 8, Schneider et al. suggests "*...a security element that is prepared on a separate carrier layer, for example a plastic foil...*". (Page 5, lines 25-26), however, fails to teach wherein the substrate comprises cotton paper or paper with a mixture of cotton/synthetic fiber. Royer discloses wherein "*...base 14 is made of a flexible material of low thickness, for example a piece of a polyester sheet.*" (Col. 2, lines 59-61).

Krut et al. teaches "*...a paper-based substrate for use in security documents, banknotes and the like, in which an integrated circuit is incorporated...*" (Col 1, lines 37-41), where "*...paper is understood to mean paper which is made from natural or synthetic fibres, as well as "paper" which can nowadays be produced from plastic films, which paper is used for the production of security paper, banknotes, and the like.*" (Col. 2, lines 4-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize any one of many types of paper products available as a substrate for a self-adhesive security label as suggested by both prior art references, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design variation. In re Leshin, 125 USPQ 416.

### ***Examiner's Note***

Examiner has cited particular column and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art as disclosed by the Examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385. The examiner can normally be reached on Monday-Friday 8:30 AM to 5:30 PM EST ALT Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Nguyen can be reached on (571) 272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

msa

/Jacob Y Choi/

Primary Examiner